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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,312	07/01/2002	Elizabeth A. Arndt	59405	6411

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POLSINELLI SHALTON & WELTE, P.C.
700 W. 47TH STREET
SUITE 1000
KANSAS CITY, MO 64112-1802

EXAMINER

TRAN LIEN, THUY

ART UNIT PAPER NUMBER

1761

DATE MAILED: 01/31/2003

13 2

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/064,312

Applicant(s)
Arndt et al.

Examiner
Lien Tran

Art Unit
1761



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 1, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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1. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1: Lines 3-4 are vague and indefinite; the phrase " wherein between 50-90% by weight of said food product used to form the product" is confusing. What food product and what product is the line referring to. Also, it is not clear if the food product comprises an amount of grain and Prowashonupana barley or the grain is the Prowashonupana barley. Line 6 is vague and indefinite because it only recites extruding and cooking the grain; what about the barley flour? Also, the term " elevated glycemic index" is indefinite because what would be considered as " elevated"; there is no comparative basis.

In claim 6, the term " elevated glycemic index" has the same problem as claim 1.

In claim 8: Line 5 is indefinite; what does applicant mean by " extruding said food product". The food product is the end product.

2. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. .

Claim 1 recites a method for not contributing to an elevated glycemic index; the method consists of the steps of forming a food product and consuming such food product. However, it is not known how much of the food product is to be consumed to not contribute to an elevated glycemic index and what would be considered as an elevated glycemic index.

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Becker et al in view of McWard.

Becker et al disclose a process for producing snack food product with high dietary fiber content. The product comprises from about 5-30% by weight of dietary fiber and it is formed by extruding. The product is intended to be used in food product or food supplements which are specifically formulated to help delay glucose absorption and reduce postprandial glucose and insulin serum peaks. Such a product would be intended as a therapeutic for diabetes and similar diseases. The dietary fiber can be derived from grains such as corn, wheat, barley, rye, soy, rice,

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oats and mixtures thereof. Flours made from the above grains are also useful. The proportions of fiber can be varied to accommodate desired fiber content, taste, mouthfeel and texture. (See columns 3-6)

Becker et al do not disclose the barley is a Prowashonupana barley extruding at a temperature high enough to cook the grains.

McWard discloses Prowashonupana barley has high beta glucan and dietary fibre content and can replace wheat flour in various food products. Research has been done to determine its use in controlling diabetes.

It would have been obvious to one skilled in the art at the time of the invention to select Prowashonupana barley for the dietary fiber source of the food product disclosed by Becker et al because McWard teaches this type of barley has high fibre content and has been implicated in controlling diabetes. Thus, the selection of the Prowashonupana barley is beneficial to the Becker et al objective of obtaining a high dietary fiber content and as a therapeutic for diabetes. As to the amount, Becker et al disclose the amount can varied to accommodate desired fiber content, taste, mouthfeel and texture; thus, it would have been obvious to one use a large amount of barley to obtain a high fiber content or vice versa. McWard teaches the barley can be used to replace wheat flour; thus, this suggests that the barley does not have any objectionable taste. It would have been obvious to one skilled in the art to use the Becker et al food product to control the glycemic index after food consumption because Becker et al teach the food product can be specifically formulated to help delay glucose absorption and reduce postprandial glucose and

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insulin serum peaks. Such a product would be intended as a therapeutic for diabetes. The amount to be consumed varies among individual condition and the objective to be obtained; such amount can be determined by one skilled in the art through routine experimentation and the RAG value is expected to be similar because the Becker et al food is intended to perform the same function as claimed. Becker et al do not disclose the extrusion temperature as claimed; however, variation in temperature is common in food processing. For example, it would have been obvious to use lower temperature for a longer period of time or vice versa. Becker et al disclose that no baking, cooking or toasting or the like is necessary; this indicates that the product is cooked during extrusion because grains such as corn, wheat, barley, rye, soy, rice, oats and flours made from such grains are used and one can not consume raw flour or grains.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6503555B1 . Although the conflicting claims are not identical, they are not patentably distinct from each other because both the application and the patent claims are directed to food product designed for not contributing to an elevated glycemic index. It would have been obvious to use the food product of the patent to carry out the method in the instant application because it consists of the same ingredients and performs the same function. It would also have been obvious to use the Prowashonupana barley as now claimed because the food product in the patent is also made of the same barley flour. It would have been within the skill one in the art to determine the method of cooking and the temperature required to form the food product.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lien Tran whose telephone number is 703-308-1868. The examiner can normally be reached on Wed-Fri. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

January 21, 2003


LIEN TRAN
PRIMARY EXAMINER
Group 1700